

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE ROBERTO F. MOREIRA
and
ORLANDO JOSE S. RIBEIRO

Appeal No. 1997-1081
Application No. 08/111,922¹

HEARD: May 4, 1999

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 through 8, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed August 26, 1993.

BACKGROUND

The appellants' invention relates to a shearable riser joint. A substantially correct copy of claims 6 through 8 appears in the appendix to the appellants' brief.²

No prior art references are relied upon by the examiner in rejecting the appealed claims.³

Claims 6 through 8 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

² Claim 8 contains a minor error in that claim 8 depends from claim 7, not claim 6.

³ The filewrapper of this application fails to reveal that the examiner searched this application. Upon return of this application to the examiner, the examiner should ensure that the required search be performed and recorded in the filewrapper of this application.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 13, mailed August 21, 1995) and the examiner's answer (Paper No. 20, mailed September 12, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 18½, filed April 22, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification⁴ and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

⁴ The appellants filed a substitute specification on August 29, 1994. It does not appear from the record that the entry or nonentry of this substitute specification has been communicated to the appellants. Page 1 of the substitute specification contains a clerical marking of NE (i.e., not entered). Accordingly, we will rely on the original specification in deciding the issues raised in this appeal.

The enablement issue

We will not sustain the rejection of claims 6 through 8 under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. The threshold step in resolving this issue is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning

inconsistent with enablement. This the examiner has not done. While the appellants' disclosure fails to specify the actual construction of various elements (e.g., column hoist running tool, riser column, riser joint, riser bolt, re-entry mandrel, riser box, recovery tool, etc.) it is our opinion that this alone is not a sufficient basis, in this case, to meet the examiner's burden of proof. This is especially true in view of the fact that the record establishes that such elements were all known as of the date of the appellants' application.^{5,6} In this regard, the examiner should note MPEP § 2164.05(a) (7th Ed., July 1998) which provides that the specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. Thus, we conclude that appellants' disclosure would

⁵ See, for example, the article entitled "Deepwater Subsea Completion: State of the Art and Future Trends" (1993) submitted by the appellants on May 1, 1995 as an attachment to the amendment under 37 CFR § 1.115 (Paper No. 12).

⁶ See also the appellants' argument set forth on pages 6-9 of the brief.

have enabled a person of ordinary skill to make and use the appellants' invention without undue experimentation.

The indefiniteness issue

We will not sustain the rejection of claims 6 through 8 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C.

§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Inter. 1992).

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries

of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we are unable to sustain any of the rejections under 35 U.S.C. § 112, second paragraph, made by the examiner (answer, p. 3) of the claims on appeal.⁷ We agree with the argument set forth by the appellants (brief, pp. 9-10) that the claim language found by the examiner to be in violation of the second paragraph of 35 U.S.C. § 112 is definite since such language does define the metes and bounds thereof with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

⁷ While we cannot sustain the examiner's basis for rejecting the claims under appeal, we suggest the following corrections to claims 7 and 8. Claim 7, line 2, change "further comprising" to "--in combination with--". Claim 8, line 4, change "the sleeve" to "--the fishing jacket means--".

CONCLUSION

To summarize, the decision of the examiner to reject claims 6 through 8 under 35 U.S.C. § 112, first and second paragraphs, is reversed.

REVERSED

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| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JEFFREY V. NASE |) | |
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APPEAL NO. 1997-1081 - JUDGE NASE
APPLICATION NO. 08/111,922

APJ NASE

APJ McQUADE

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria

Henderson

DRAFT TYPED: 10 May 99

FINAL TYPED:

HEARD: 04 May 99